

**Application 09/781,605
Amendment Dated 10 May 2005
Reply to Office Action Mailed 12 January 2005**

Remarks

In this Amendment, Claims 2 and 8 have been cancelled, and new Claims 15 through 17 have been added. Therefore, Claims 1, 3-6, and 9-17 are pending in this Application. Claims 1, 6, 12, 13 and 14 are independent.

Claims 1 through 5.

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,262,470 ("Teshima") in view of U.S. Patent 6,397,224 ("Zubeldia"). Claim 1 is independent and Claims 3-5 depend on Claim 1. Claim 2 has been cancelled.

Teshima discloses an electronic clinical recording system capable of handling an electronic record of a patient's history of medical consultations (see abstract). When a patient visits a healthcare service provider for medical consultation, a record of the consultation information, such as main complaint, findings, name of disease and orders, is recorded onto a patient card (see Figure 6). The patient can then retain the patient card and present it at subsequent medical consultations, thereby providing a comprehensive medical history for the patient (see 3:26-42).

In contrast to the systems disclosed in Teshima and Zubeldia, amended Claim 1 recites, among other elements:

- a database management server comprising:
 - a database including a plurality of fields of personal data relating to a patient and
 - an optical disk writer wherein the optical disk writer writes a patient record that includes selected fields of the personal data to the portable optical disk, said selected fields of the personal data being viewable and downloadable by the subscriber computer, and wherein said selected fields of personal data are chosen by the patient from the plurality of fields of personal data; and *[emphasis added]*

Applicants have amended Claim 1 to clarify that "selected fields of personal data are chosen by the patient from the plurality of fields of personal data" (emphasis added). The amendments to Claim 1 are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraph [0064].

The recitations of amended Claim 1 are significantly different from the teachings of Teshima, which discloses a system wherein a comprehensive medical history is

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provided on a patient card. Specifically, in the Teshima system, because the entire record of a medical consultation stored onto the patient card, the patient certainly has no control over selecting or choosing what information is stored onto the patient card. Indeed, in the Teshima system, certain information is even "recorded automatically" (see 11:46-56) during or after a medical consultation. Therefore, Teshima cannot teach the combination of elements recited in amended Claim 1.

The Examiner refers to operational block 113 of Figure 6 in Teshima as disclosing a system "wherein the personal data to be stored on the portable optical disk is selectable using the subscriber interface". Applicant respectfully disagrees with this reading of Teshima. Specifically, operational block 113 of Figure 6 discloses displaying a previous consultation record and **automatically recording** an updated consultation record to the patient card (see Teshima at 11:42-47), and therefore contains no teaching of the patient choosing or selecting certain data.

The teachings of Zubeldia cannot remedy the shortcomings of the Teshima reference. Thus, even if the teachings of Teshima and Zubeldia are combined, the combination of elements recited in amended Claim 1 are not provided by either of these references.

Based on the foregoing, Applicants submit that the combination of Teshima and Zubeldia does not render unpatentable amended Claim 1, and therefore respectfully suggest that amended Claim 1 is in condition for allowance. Furthermore, because Claims 3-5 depend from amended Claim 1, Applicants submit that Claims 3-5 are allowable over Teshima and Zubeldia for the same reasons that amended Claim 1 is allowable.

Claims 6 and 8 through 11.

Claims 6 and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Teshima in view of Zubeldia. Claim 6 is independent and Claims 9-11 depend on Claim 6. Claim 8 has been cancelled.

In contrast to the methods disclosed in Teshima and Zubeldia, amended Claim 6 recites, among other elements:

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writing a patient record onto a portable optical disk via the optical disk writer wherein the portable optical disk is readable from an optical disk drive using the Internet web browser interface, and wherein **the patient record includes selected fields of the personal data that are chosen by the patient from the plurality of fields; [emphasis added]**

Applicants have amended Claim 6 to clarify that "the patient record includes selected fields of the personal data that are chosen **by the patient**" from a plurality of fields (emphasis added). The amendments to Claim 6 are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraph [0064].

The recitations of amended Claim 6 are significantly different from the teachings of Teshima, which discloses a system wherein a comprehensive medical history is provided on a patient card. Specifically, in the Teshima system, because the entire record of a medical consultation stored onto the patient card, the patient certainly has no control over selecting or choosing what information is stored onto the patient card. Indeed, in the Teshima system, certain information is even "recorded automatically" (see 11:46-56) during or after a medical consultation. Therefore, Teshima cannot teach the combination of elements recited in amended Claim 6.

The Examiner refers to operational block 113 of Figure 6 in Teshima as disclosing a system "wherein the personal data to be updated is selectable by the subscriber". Applicant respectfully disagrees with this reading of Teshima. Specifically, operational block 113 of Figure 6 discloses displaying a previous consultation record and **automatically recording** an updated consultation record to the patient card (see Teshima at 11:42-47), and therefore contains no teaching of the patient choosing or selecting certain data.

The teachings of Zubeldia cannot remedy the shortcomings of the Teshima reference. Thus, even if the teachings of Teshima and Zubeldia are combined, the combination of elements recited in amended Claim 6 are not provided by either of these references.

Based on the foregoing, Applicants submit that the combination of Teshima and Zubeldia does not render unpatentable amended Claim 6, and therefore respectfully suggest that amended Claim 6 is in condition for allowance. Furthermore, because Claims 9-11 depend from amended Claim 6, Applicants submit that Claims 9-11 are

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allowable over Teshima and Zubeldia for the same reasons that amended Claim 6 is allowable.

Claim 12.

Claim 12 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Teshima. Claim 12 is independent.

In contrast to the system disclosed in Teshima, amended Claim 12 recites, among other elements:

entering means for entering personal data into a patient record, the personal data being organized into a plurality of fields;

storing means for storing selected fields of the personal data in a uniformly accessible manner on an optical disk, **wherein the selected fields of personal data are selected by the patient;** *[emphasis added]*

Applicants have amended Claim 12 to clarify that "the selected fields of personal data are selected **by the patient**" from a plurality of fields (emphasis added). The amendments to Claim 12 are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraph [0064].

Based on the amendments to Claim 12 presented herein, Applicants submit that Teshima does not render unpatentable amended Claim 12, and therefore respectfully suggest that amended Claim 12 is in condition for allowance.

Claim 13.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Teshima in view of U.S. Patent 6,415,295 ("Feinberg") and U.S. Patent 6,022,315 ("Iliff"). Claim 13 is independent.

In contrast to the disclosure of Teshima, Feinberg and Iliff, amended Claim 13 recites, among other elements, that:

the generic data is stored in a uniformly accessible manner and comprises physician information, healthcare facility information, and an Internet hyperlink;

Applicants have amended Claim 13 to clarify that the portable optical disk comprises "personal data relating to a patient and generic data relating to a healthcare facility", wherein the generic data comprises "physician information, healthcare facility information, and an Internet hyperlink". The amendments to Claim 13 are fully

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supported by the originally filed specification; see, for example, the disclosure provided in paragraphs [0033] and [0034].

Based on the amendments to Claim 13 presented herein, Applicants submit that the combination of Teshima, Feinberg and Iliff does not render unpatentable amended Claim 13, and therefore respectfully suggest that amended Claim 13 is in condition for allowance.

Claim 14.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Teshima in view of Feinberg and Iliff. Claim 14 is independent.

In contrast to the disclosure of Teshima, Feinberg and Iliff, amended Claim 14 recites, among other elements, a portable optical disk comprising, among other things:

generic data stored in a uniformly accessible manner wherein the generic data includes physician information, healthcare facility information, and an Internet hyperlink

Applicants have amended Claim 14 to clarify that the portable optical disk comprises, among other things, generic data that includes "physician information, healthcare facility information, and an Internet hyperlink". The amendments to Claim 14 are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraphs [0033] and [0034].

Based on the amendments to Claim 14 presented herein, Applicants submit that the combination of Teshima, Feinberg and Iliff does not render unpatentable amended Claim 14, and therefore respectfully suggest that amended Claim 14 is in condition for allowance.

New Claims 15 through 17.

New Claims 15 and 16 depend from Claim 14. These new claims are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraphs [0033], [0034] and [0064]. Distinctions between Claim 14 and the cited references were specifically discussed herein. Because new Claims 15 and 16 depend from Claim 14, and further distinguish the claimed invention from the cited references,

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Applicants submit that new Claims 15 and 16 are allowable over the cited references for at least the same reasons that Claim 14 is allowable over the cited references.

New Claim 17 depends from Claim 1. These new claims are fully supported by the originally filed specification; see, for example, the disclosure provided in paragraphs [0033] and [0034]. Distinctions between Claim 1 and the cited references were specifically discussed herein. Because new Claim 17 depends from Claim 1, and further distinguishes the claimed invention from the cited references, Applicants submit that new Claim 17 is allowable over the cited references for at least the same reasons that Claim 1 is allowable over the cited references.

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Conclusion.

Applicant respectfully submits that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.


If some issue remains that the Examiner feels can be addressed by an Examiner's Amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

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AMEND

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